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| 10/722,238 | 11/24/2003 | Terrance A. Tomkow | RPOST-66230 | 6674 |
| 24201 7590 07/13/2007 FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045 | | | EXAMINER TAYLOR, NICHOLAS R | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/722,238

Applicant(s)

TOMKOW, TERRANCE A.

Examiner

Nicholas R. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 19-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/26/04.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 7/5/07.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-23 were presented. Claims 1-18 were elected and are rejected.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a method of indicating opened messages using encrypted hashing, classified in class 709, subclass 206.
 - II. Claims 19-23, drawn to monitoring and transferring unique ID data that is based on sender and recipient information, classified in class 709, subclass 224.
3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility as a method of indicating opened messages using encrypted hashing. Subcombination II has separate utility as a method of tracking and managing unique user ID information in a messaging system. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the

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allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. During a telephone conversation with Ellsworth R. Rosten, Reg. No. 16,310, on June 20th, 2007, a provisional election was made without traverse to prosecute the invention of group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because page 18 (figure 12) is hand-drawn and difficult to read. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

6. The claims are objected to because of the following minor informalities:

In claim 7: "of the opening of the message the recipient."

In claim 9: "message at the reception."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is rejected for the use of "including the indication of the interim stations which receive the message during the transmission of the message" without proper antecedent basis. The earlier introduced "indication" indicates the opening of the message at the recipient. Claim 13 also uses "the attachment" without proper antecedent basis." For the purposes of this office action, it is assumed that claim 13 has a similar basis as the language in claims 1 and 7.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-18 are provisionally rejected on the ground of nonstatutory double patenting over claims 115-121 of copending Application No. 09/626577, as filed

5/18/2007. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: independent claim 115's scope includes the limitations present in claims 1-18, including a displaced server receiving a message from a sender, sending the message to a destination recipient, receiving the original message along with verification of the message (via an "indication" in the present application), and transmitting the verification to the sender.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Barkan, (International Pub. No. WO 98/17042).

13. As per claim 1, Barkan teaches a method of transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of:

receiving the message at the server from the sender, transmitting the message from the server to the recipient, (Barkan, pages 29 and mail server 31 of fig. 1)

and the message including a pixel for indicating the opening of the message at the recipient at the server, (Barkan, pages 30-31)

providing an encrypted hash of the message, including the indication of the opening of the message at the recipient, at the server, and transmitting the message, including the indication of the opening of the message at the recipient, and the encrypted hash to the sender (Barkan, pages 33-34).

14. As per claim 2, Barkan teaches the system further including the steps at the server of:

receiving at the server the message, including the indication of the opening of the message at the recipient and the encrypted hash of the message, and determining the authenticity of the message, including the opening of the message at the recipient, on the basis of the hash of the message, including the indication of the opening of the message at the recipient, and the hash decrypted from the encrypted hash (Barkan, page 32, where the server compares hash values to determine that the recipient received the message correctly).

15. As per claim 3, Barkan teaches the system further including the steps at the server of: receiving from the sender the message, including the indication of the opening of the message at the recipient, and the encrypted hash of the message, including the indication of the opening of the message at the recipient, hashing the message, including the indication of the opening of the message the recipient, to provide a first digital fingerprint of the message including the indication of the opening of the message at the recipient, (Barkan, page 23)

decrypting the encrypted hash of the message, including the indication of the message at the recipient, to provide a second digital fingerprint of the message including the indication of the opening of the message at the recipient, and comparing the first and second digital fingerprints to determine the authenticity of the message including the indication of the opening of the message at the recipient (Barkan, page 32, where the server compares hash values to determine that the recipient received the message correctly).

16. As per claim 4, Barkan teaches the system further including the steps at the server of:

indicating to the sender the results of the comparison, and (Barkan, page 33)
disposing of the message, and including the indication of the opening of the message at the recipient, and the encrypted hash of the message, including the

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indication of the opening of the message at the recipient, when the message and the encrypted hash are transmitted by the server to the sender (Barkan, page 35).

17. As per claim 5, Barkan teaches the system further wherein the server receives the message from the sender through the internet, the server transmits the message to the recipient through the internet, the server receives the message, including the indication of the opening of the message the recipient, through the internet, and the server transmits the message, including the indication of the opening of the message at the recipient, through the internet to the sender (Barkan, see page 13):

As per claim 6, Barkan teaches the system further wherein the server indicates the results of the compression to the sender through the internet and wherein the server disposes of the message, including the indication of the opening of the message at the internet, and the encrypted hash of the message, including the indication of the opening of the message, when the message and the encrypted hash are transmitted by the server to the sender through the internet (Barkan, see page 13).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan, (International Pub. No. WO 98/17042) and Ouchi (U.S. Patent No. 5,978,836).

20.

21. As per claims 7 and 13, Barkan teaches a method of transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of:

receiving the message at the server from the sender, transmitting the message from the server to the recipient, (Barkan, pages 29 and mail server 31 of fig. 1)

the message including a pixel for indicating the opening of the message at the recipient, (Barkan, pages 30-31)

receiving the message, including the indication of the opening of the message the recipient, at the server, (Barkan, pages 32-33, where the user replies with an opened indication including the message)

providing encrypted hashes of the message, including the indication of the opening of the message at the recipient, and the attachment, and transmitting to the sender the message, including the indication of the opening of the message the recipient, and the attachment, and the encrypted hashes of the message, including the opening of the message at the recipient, and the attachment (Barkan, pages 33-34).

Barkan fails to teach receiving an receiving an attachment including an indication of the interim stations which receive the message during the transmission of the message from the server to the recipient and back to the server.

Ouchi teaches an email communication and notification system that provides an attachment that lists the interim stations which receive a message during the transmission of the message from the server to the recipient and back to the server (Ouchi, see fig. 9, col. 12, lines 11-15, and col. 5, lines 16-42).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Barkan and Ouchi to provide the email method of Ouchi in the system of Barkan, because doing so would provide increased security and verification by providing the sender with information on all systems that transmitted the message (Ouchi, col.2, lines 1-12).

22. As per claim 8, Barkan-Ouchi teaches the system further including the steps at the server of:

receiving at the server the message, including the indication of the opening of the message at the recipient, the attachment and the encrypted hashes of the message, including the indication of the opening of the message at the recipient, and the attachment, and determining the authenticity of the message, including the opening of the message at the recipient, on the basis of the hash of the messages, including the indication of the opening of the message at the recipient, and the hash decrypted from the encrypted hash and the authenticity of the attachment on the basis of the hashed attachment and the hash decrypted from the encrypted hash of the attachment (Barkan, page 32, where the server compares hash values to determine that the recipient received the message correctly).

23. As per claims 9 and 15, Barkan-Ouchi teaches the system further including the steps at the server of:

reviewing from the sender the message, including the indication of the opening of the message at the recipient, the encrypted hash of the message, including the indication of the opening of the message at the reception, the attachment and the encrypted hash of the attachment, hashing the message, including the indication of the opening of the message the recipient, and the attachment to provide first digital fingerprints of the message, including the indication of the opening of the message at the recipient and the attachments, (Barkan, page 23)

decrypting the encrypted hash of the message, including the indication of the opening of the message at the recipient, and the attachment to provide second digital fingerprints of the message, including the indication of the opening of the message at the recipient and the attachment, and comparing the first and second digital fingerprints of the message, including the indication of the opening of the message at the recipient, to determine the authenticity of the message, including the indication of the opening of the message at the recipient and first and second fingerprints of the attachment to determine the authenticity of the attachment (Barkan, page 32, where the server compares hash values to determine that the recipient received the message correctly).

24. As per claims 10 and 16, Barkan-Ouchi teaches the system further including the steps at the server of:

indicating to the sender the results of the comparisons, and (Barkan, page 33) disposing of the message, including the indications of the opening of the message at the recipient, and the encrypted hash of the message, including the indication of the opening of the message at the recipient, and the attachment and encrypted hash of the attachment when the message, the attachment and the encrypted hashes are transmitted by the server to the sender (Barkan, page 35).

25. As per claim 11, Barkan-Ouchi teaches the system further wherein the server receives the message from the sender through the internet and wherein the server transmits the message to the recipient through the internet and wherein the server reserves the message, including the indication of the opening of the message at the recipient, to the recipient through the internet and wherein the server transmits the message through the internet to the sender (Barkan, see page 13).

26. As per claim 12, Barkan-Ouchi teaches the system further wherein the server indicates the results of the comparison to the sender through the internet and wherein the server disposes of the message, the attachment and the encrypted hashes of the message and the attachment when the message and the encrypted hash are transmitted by the server to the sender through the internet (Barkan, see page 13).

27. As per claim 14, Barkan-Ouchi teaches the system further including the steps at the server of: receiving the message, the attachment and the encrypted hash of the

combination of the message and the attachment from the sender, hashing the combination of the message and the attachment to provide a first digital fingerprint and decrypting the encrypted hash of the combination of the message and the attachment to form a second digital fingerprint, and determining the authenticity of the message and the attachment on the basis of the first and second digital fingerprints (Barkan, page 32, where the server compares hash values to determine that the recipient received the message correctly).

28. As per claims 17, Barkan-Ouchi teaches the system further wherein the server receives the message from the sender through the internet, the server transmits the message to the recipient through the internet, the server receives the message, including the indication of the opening of the message the recipient, through the internet, and the server transmits the message, including the indication of the opening of the message at the recipient, through the internet to the sender (Barkan, see page 13).

29. As per claims 18, Barkan-Ouchi teaches the system further wherein the server indicates the results of the compression to the sender through the internet and wherein the server disposes of the message, including the indication of the opening of the message at the internet, and the encrypted hash of the message, including the indication of the opening of the message, when the message and the encrypted hash are transmitted by the server to the sender through the internet (Barkan, see page 13).

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes:

U.S. Patent No. 6,618,747, which describes an electronic communication delivery notification system;

U.S. PGPub 2004/0143650 describes a method of sending email through an intermediary with notification services; and

U.S. PGPub 2002/0007453, which describes a system of secure message transmission with receipt notification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

~~JASON CARDONE~~
~~SUPERVISORY PATENT EXAMINER~~

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NT 7-5-07

Nicholas Taylor
Examiner
Art Unit 2141


JASON CARDONE
SUPERVISORY PATENT EXAMINER